UNITED STATES PATENT AND TRADEMARK OFFICE
Commissioner for Trademarks
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Alexandria, VA 22313-1451

Lykos

Mailed: October 29, 2004

Opposition No. **91123765**

CENTRAL MFG. CO.

v.

PARAMOUNT PARKS, INC.

Before Bottorff, Rogers and Drost, Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of (1) opposer's motion (filed April 8, 2004) for reconsideration of the Board's decision to deny opposer's first motion for summary judgment; (2) opposer's motion (filed April 8, 2004) to amend its notice of opposition; and (3) opposer's second motion (filed June 4, 2004) for summary judgment. The motions are fully briefed.[1]

Relevant Background

By way of relevant background, on October 15, 2002, opposer filed a motion for summary judgment on several

[1] In its second motion for summary judgment, opposer withdrew its motion (filed June 2, 2004) to extend discovery.

Opposer's motion (filed July 26, 2004) to extend its time to file a reply in support of its second motion for summary judgment is granted as conceded. *See* Trademark Rule 2.127(a).

grounds, including that applicant's applied-for mark[2] HYPERSONIC is likely to cause confusion with opposer's pleaded registration for the mark HYPERSONIC;[3] that Viacom, Inc., not applicant, is the owner of the mark in the applications at issue in this proceeding; that applicant's failure to disclose its relationship with Viacom is fatal to its applications; that applicant only intends to use its mark in intrastate commerce; that applicant has not established a valid first use date; that applicant did not have a bona fide intent to use the mark when it filed its applications and did not have actual use when it filed its "Statements to Amend Use"; and that applicant made misrepresentations to the Board in its amendments to allege

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The Board has exercised its discretion to consider opposer's reply briefs in support of the above referenced motions. *See id.*

[2] Intent-to-use application Serial No. 76103448, filed August 2, 2000, for the mark HYPERSONIC for "paper goods and printed matter, namely calendars, fiction magazines, comic books, greeting cards, posters, a series of fiction books, trading cards, stickers, notepads, and books, postcards, gift wrapping paper, bumper stickers, and rubber stamps" in International Class 16; and intent-to-use application Serial No. 76103447, filed August 2, 2000, for the mark HYPERSONIC for "T-shirts, sweatshirts, hats, jackets, pajamas, masquerade costumes, tank tops, footwear, sweatpants [and] shorts" in International Class 25.

[3] Registration No. 1593157 for the mark HYPERSONIC for "sports racquets, namely tennis racquets, racquetball racquets, squash racquets, badminton racquets; golf clubs, golf balls, tennis balls, sports balls, namely basketballs, baseballs, footballs, soccer balls, volleyballs; crossbows, racquet strings and shuttlecocks" in International Class 28.

use. Opposer also moved for permission to file a brief in excess of 25 pages in support of its motion for summary judgment.

The Board, in an order dated March 9, 2004, denied opposer's motion for leave to file a brief in excess of 25 pages, and found that opposer had failed to sustain its burden of showing that no genuine issue of material fact exists as to any of the grounds on which it moved for summary judgment. Specifically, the Board noted that in view of applicant's counterclaim to cancel opposer's pleaded registration based on a claim of abandonment and because "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce . . . a genuine issue of material fact exists as to whether opposer has standing to maintain this proceeding." The Board noted further that as to opposer's claim of likelihood of confusion, "genuine issues exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they came from the same source, and whether applicant's intended use of the mark on the goods would constitute use in commerce."

The Board also found that opposer's allegation in its summary judgment motion that applicant is not the owner of

the involved mark was not properly pleaded in the notice of opposition, and therefore would be given no consideration.

In addition, the Board determined that although applicant filed amendments to allege use in connection with both of its applications, those amendments were untimely and would be given no consideration, and that any of opposer's allegations regarding applicant's specimens of use would be a matter for *ex parte* examination and not the basis for *inter partes* claims.

In order to avoid future disputes regarding the timeliness of service of papers, the Board imposed the requirement that the parties file and serve all papers in this proceeding using the "Express Mail" procedure described in Trademark Rule 1.10 or by another overnight courier.

Opposer's Request for Reconsideration

Considering first opposer's motion for reconsideration, opposer asserts that the Board abused its discretion in denying opposer's motion for leave to file a brief in excess of 25 pages; that the Board made a clear error in finding that there is no evidence of record in support of opposer's claim of use of its pleaded HYPERSONIC mark in commerce because opposer has a valid and subsisting federal registration; that the fact that applicant counterclaimed to cancel opposer's pleaded registration does not raise a genuine issue of material fact; that applicant, in its

counterclaim, failed to meet its burden of proof of abandonment; that "it is clear" that applicant is only using its mark in intrastate commerce; and that the Express Mail requirement imposes a "burdensome, oppressive and unnecessary hardship" on opposer.

In opposition thereto, applicant argues that opposer contends in a "conclusory fashion" that the Board's decision was erroneous as to the claims of likelihood of confusion and non-use in interstate commerce; that opposer has failed to raise any new arguments on these issues; that opposer's argument that applicant has failed to meet its burden of proof on its counterclaim for abandonment of opposer's pleaded registration is premature; that the Board correctly pointed out that the issue of abandonment of opposer's pleaded registration was one issue of disputed fact; that opposer's failure to fully respond to applicant's discovery requests is further evidence that a genuine issue of material fact exists regarding the status of opposer's pleaded registration; and that the requirement of service by Express Mail was entirely appropriate given the questions regarding the timeliness of opposer's discovery responses.

In reply, opposer reiterates its position that the Board failed to give proper weight to the presumption of validity of its pleaded registration, and that applicant is attempting to mislead the Board by asserting that opposer

has failed to fully comply with applicant's discovery requests.

Requests for reconsideration, as provided in Trademark Rule 2.127(b), provide a party with an opportunity to point out any error that the Board may have made in its initial consideration of a matter. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion.

After carefully reviewing the parties' arguments and submissions, we find that opposer's motion for reconsideration is not well-taken. The Board properly found genuine issues of material fact in dispute which required denial of opposer's summary judgment motion. It was unnecessary for the Board to provide an exhaustive list of issues in dispute in its order; if there is a single genuine issue of material fact, summary judgment cannot be granted.

As to the validity of opposer's pleaded registration and applicant's counterclaim for abandonment, opposer has failed to show how the Board erred in finding that opposer failed to introduce any documents as evidence of use in commerce of its pleaded mark. Moreover, opposer’s legal arguments regarding the effect of the presumption of validity of a federal registration are incorrect. Although a federal registration creates a presumption of validity,

that presumption is subject to rebuttal. *See* 15 U.S.C. §1064. In this case, opposer's registration is under attack because applicant has filed a counterclaim to cancel opposer's registration which is the legal equivalent of a petition to cancel. *See* TBMP §313.01 and authorities cited therein.

In addition, there is no evidence that the Board abused its discretion in denying opposer's motion for leave to file a brief in excess of 25 pages. The case before us does not involve consolidated proceedings, nor were exceptional circumstances presented to justify a lengthier brief.

Finally, the Board's imposition of the Express Mail requirement in this proceeding was completely justified in light of opposer's conduct. The Board has discretion to impose requirements or sanctions on parties in order to ensure orderly conduct in a proceeding.[4] *See S. Industries Inc. v. Lamb-Weston, Inc.,* 45 USPQ2d 1293 (TTAB 1997). This requirement does not present in any way an undue burden on either party.

In view of the foregoing, opposer's motion for reconsideration is denied.

[4] As to applicant's assertions that opposer has failed to fully respond to applicant's outstanding discovery requests, the motions before us do not present a proper forum for deciding this issue; such an issue may only be determined by the Board upon the filing of a motion to compel. *See* Trademark Rule of 2.120(g).

Opposer's Second Motion for Summary Judgment

Next, we turn to opposer's second motion for summary judgment. Opposer has again moved for summary judgment on its claims of likelihood of confusion and priority of use, and has also moved for summary judgment on actual confusion and applicant's counterclaim of abandonment of opposer's pleaded registration. To support its renewed motion for summary judgment, opposer has submitted the discovery depositions noticed and taken by applicant of Mr. Leo Stoller, an officer of opposer, and Mr. Raymond Webber, a "third-party fact witness," and various exhibits attached thereto, including catalog sheets and sales quote sheets for HYPERSONIC products; the declaration of Mr. Stoller; and opposer's pleaded registration.

In opposition to opposer's second summary judgment motion, applicant argues that opposer's depositions attesting to use in interstate commerce are merely "self-serving;" that aside from the depositions, opposer has provided no documentary proof that it has used the mark in its pleaded registration in interstate commerce; that specifically, opposer has submitted no purchase orders, invoices, sample products, statements, letters, or receipts to substantiate even a single sale of merchandise any time since 1988; that an informal telephone survey of some of opposer's alleged customers conducted by counsel for

applicant reveals opposer has not made any actual use of its mark in commerce; that opposer has failed to meet its burden of proof on its claims of likelihood of confusion and actual confusion and as such a genuine issue of material fact exists regarding the relatedness of the parties' respective goods, trade channels, and prospective consumers; that opposer still has not provided complete responses to applicant's discovery requests; and that the purpose of opposer's renewed motion for summary judgment is to forestall discovery in this proceeding.

In reply, opposer contends that the "unrefuted" evidence presented by opposer is sufficient to warrant entry of summary judgment against applicant; that the investigation conducted by applicant's counsel regarding opposer's non-use of its pleaded mark is flawed; that opposer has met its burden of proof on its claim of likelihood of confusion because the marks at issue are identical; that opposer has clearly established priority of use; and that applicant has failed to meet its burden of proof for abandonment.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the

absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S.Ct. 2548 (1986). The evidence of record and any reasonable inferences that may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Having carefully considered the materials and arguments submitted by the parties in connection with opposer's second summary judgment motion, we conclude that there are genuine issues of material fact that preclude granting opposer's motion. The second motion offers new evidence regarding the issues of priority, purported actual confusion, and opposer's use of its mark in its pleaded registration, but does not established the absence of genuine issues of material fact about these issues for on the issue of likelihood of confusion.

We find genuine issues still exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they came from the same source, and as to whether applicant’s and opposer's goods travel in the same trade channels and are intended for the same prospective consumers.

Also, there remains an issue as to whether opposer has ever made and continues to make use of its mark in interstate commerce, and, if so, whether such use is continuing. Opposer's primary evidence thereof consists of oral evidence. In general, "oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." *Powermatics, Inc. v. Globe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). Such testimony, however, should "not be characterized by contradictions, inconsistencies and indefiniteness but should carry with it conviction of its accuracy and applicability." *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945). We agree with applicant that the depositions and declaration submitted by opposer are indefinite, lacking in specifics, and have no corroborating evidence in support of opposer's claim of priority of use sufficient to establish no genuine issue of fact and warrant dismissal of applicant's counterclaim of abandonment on summary judgment. *See S Industries Inc. v. Stone Age Equipment Inc.,* 49 USPQ2d 1079, 1082 (N.D. Ill. 1998)(the court found Mr. Stoller's declaration and deposition testimony regarding use of its mark in commerce "self-serving . . . without factual support in the record" and "uncorroborated.")

In addition, we find the telephone survey submitted by counsel for applicant raise a genuine issue of material fact as to whether opposer has used its pleaded mark in commerce.

Finally, we consider opposer's allegation of actual confusion which is based on the deposition of Mr. Weber. For the same reasons noted above, the Board finds that this evidence alone is insufficient to carry opposer's burden of proof on of summary judgment.

Accordingly, opposer's second motion for summary judgment is denied.[5]

In view of the fact that this is opposer's second motion for summary judgment on several of the same grounds, and that both motions have been denied by the Board, opposer is hereby ordered not to file any further summary judgment motions in this case.

Opposer's Motion to Amend the Notice of Opposition

Finally, we consider opposer's motion to amend its notice of opposition. Opposer seeks to add several allegations in its notice of opposition, including:

> 23. At the time the Applicant filed the said Application, it was not the owner of the mark.

[5] The parties should note that all evidence submitted in support of and in opposition to applicant's motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered in final hearing must be properly introduced in evidence during the appropriate trial periods. *See Levi Strauss & Co. v. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti,* 219 USPQ 911 (TTAB 1983).

> 24. Applicant failed to disclose its relationship with Viacom International, Inc. at the time it filed its said trademark Application which is fatal to Applicant's said application.

Opposer contends that because discovery remains open, applicant would not be prejudiced by the proposed amendments.

In response thereto, applicant opposes the motion on the grounds that opposer waited nearly three years to file the amendment; that to amend the notice of opposition at this stage in the proceeding would be prejudicial to applicant; that opposer previously made these allegations regarding Viacom in its first motion for summary judgment; that in response, applicant proffered an affidavit as evidence that Paramount Parks is a fully functioning separate entity from Viacom; and that therefore, opposer's sole purpose in asserting these allegations is to harass applicant.

In reply, opposer contends that motion is not untimely because the case has been suspended for most of the time; that the allegations opposer made regarding ownership of the mark are necessary because they were argued in opposer's first motion for summary judgment and the Board stated that it would not rule on the claims because they were not properly pleaded.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.[6] *See, for example, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *and United States Olympic Committee v. O-M Bread Inc.,* 26 USPQ2d 1221 (TTAB 1993). The timing of the motion for leave to amend is a major factor in determining whether applicant would be prejudiced by allowance of the proposed amendment. *See* TBMP § 507.02 and cases cited therein.

In this instance, the Board finds that opposer did not unduly delay in seeking to amend its notice of opposition. As opposer correctly notes, this case was suspended following the filing of opposer's first summary judgment motion. Opposer sought to raise these allegations earlier in its first summary judgment motion; however, the Board noted that it would not consider the allegations because they were not properly pleaded.

[6] An unsuccessful attempt to gain summary judgment on an unpleaded ground does not provide strong support for a motion to amend a pleading.

The Board finds that allowing the amendments would be futile. The underlying legal theory of these allegations is that applicant, Paramount Parks, by virtue of being a wholly-owned subsidiary of Viacom cannot independently own the trademark applications it filed with the Office. The premise of opposer's legal argument is faulty because wholly-owned subsidiaries can own trademarks. *See* Trademark Manual of Examining Procedure ("TMEP") § 1201.03(c). Moreover, when opposer originally raised this allegation in its first summary judgment motion, applicant, in response, submitted an affidavit, which has been unchallenged, stating that Paramount Parks, not Viacom, is the owner of the applications at issue here. Accordingly, opposer's motion to amend the notice of opposition to add paragraphs 23 and 24 is denied.

Next, we turn to opposer's proposal to add the following allegation to its notice of opposition:

> 36. During the pendency of this opposition, the Applicant attempted to amend its said application without the permission of Opposer, and without permission of the Board.

Again, the Board finds that this allegation would be futile. As noted earlier, the Board in its March 9, 2004 order ruled that it would not consider applicant's amendments to allege use filed during the blackout period, and that any objections opposer raised to the specimens of

use would be a matter for *ex parte* examination. As such, such allegations cannot serve as a claim in an opposition proceeding. Accordingly, opposer's motion to amend the notice of opposition to add paragraph 36 is denied.

Finally, the Board turns to the following amendments opposer seeks to make in its notice of opposition. Opposer seeks to add the following allegations:

8. The Opposer has priority of use, as early as 1988, on similar, related and competitive goods.

12. . . . Opposer's mark became famous in 1990.

Opposer seeks to delete the following allegations from its original notice of opposition:

17. . . . For Applicant was in fact using its mark on the goods in the said application prior to August 2, 2000, the filing date of Applicant's alleged Intent to Use applications.

19. b. Upon information and belief Mallory Levitt, Esq., in-house counsel for Viacom/Paramount, and counsel for the applicant Lance Koonce, Esq. and Marcia B. Paul knew or should have known that Paramount/Viacom has been using the said mark on some or all of the goods listed in said Applicant's prior to Applicant filing its intent to use Application, in violation of 37 CFR §10.23(a)(4).

20. Applicant has been using the mark listed in Application SN: 76,103,447 prior to filing its application on August 2, 2000, when the goods listed in [its] said application.

22. Applicant has been using the mark listed in Application SN: 76,103,447 prior to filing its intent to use application on August 2, 2000, on the goods listed in [its] said application.

Counsel for applicant has stated that these proposed amendments are relatively minor. Furthermore, the above

noted allegations opposer seeks to add effectively constitute an amplification of or withdrawal of allegations previously made in the original notice of opposition. Accordingly, opposer's motion to amend the notice of opposition with respect to paragraphs 8, 12, 17, 19, 20, and 22 is granted.

Applicant is allowed until thirty (30) days from the mailing date of this order to file an amended answer to opposer's amended notice of opposition, namely to paragraphs 8 and 12.

Trial Dates Reset

Proceedings herein are resumed, and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	November 12, 2004
30-day testimony period for party in position of plaintiff to close:	February 10, 2005
30-day testimony period for party in position of defendant in the opposition and plaintiff in the counterclaim to close:	April 11, 2005
30-day rebuttal testimony period for defendant in the counterclaim and plaintiff in the opposition to close:	June 10, 2005
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	July 25, 2005

Briefs shall be due as follows: [See Trademark Rule 2.l28(a)(2)].

Brief for plaintiff in the opposition shall be due:	September 23, 2005
Brief for defendant in the opposition and plaintiff in the counterclaim shall be due:	October 23, 2005
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff in the opposition shall be due:	October 23, 2005
Reply brief, if any, for plaintiff in the counterclaim shall be due:	November 7, 2005

If the parties stipulate to any extension of these dates, the papers should be filed in triplicate and should set forth the dates in the format shown in this order. See Trademark Rule 2.121(d).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.